



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/578,512

04/05/2007

Christian Funke

2400.0370000/VLC/CMB

4985

26111

7590

12/30/2009

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER

PAK, JOHN D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

12/30/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,512	<b>Applicant(s)</b> FUNKE ET AL.	
	<b>Examiner</b> John Pak	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

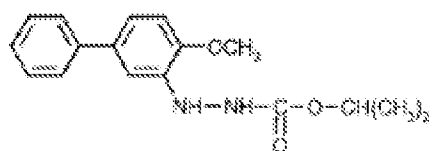
Art Unit: 1616

Restriction is required under 35 U.S.C. 121 and 372.

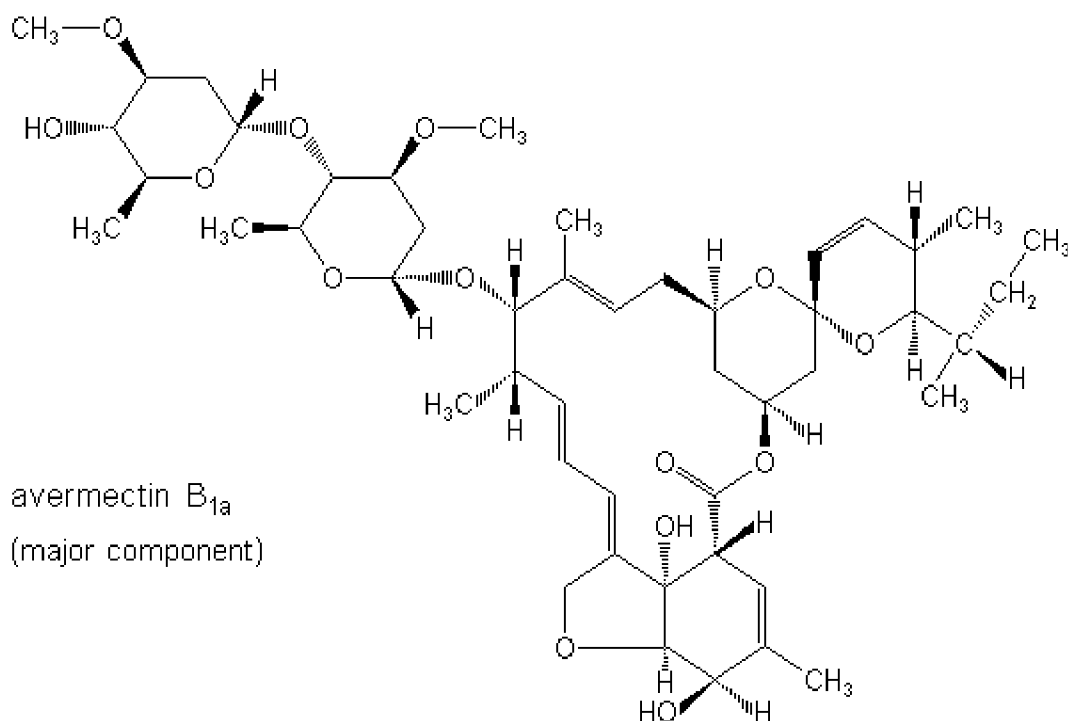
This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-1), which is bifenazate:

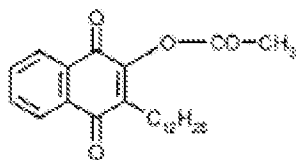


Group II, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-2), which is abamectin:

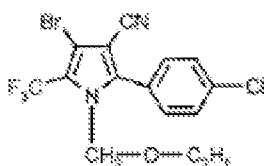


Art Unit: 1616

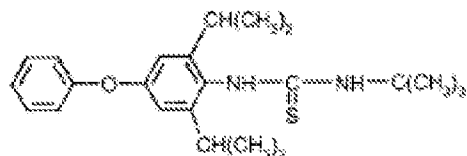
Group III, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-3), which is acequinocyl:



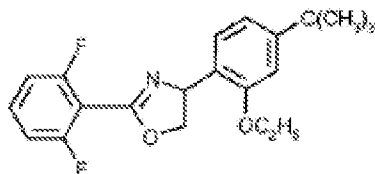
Group IV, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-4), which is chlorfenapyr:



Group V, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-5), which is diafenthiuron:

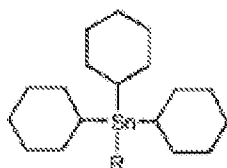


Group VI, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-6), which is etoxazole:



Art Unit: 1616

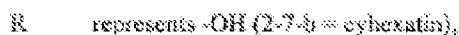
Group VII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-7), which is an organotin derivative having the structure:



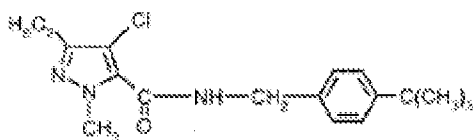
in which



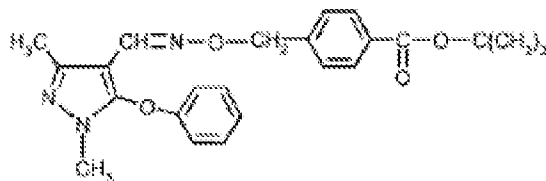
or



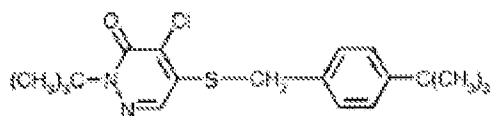
Group VIII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-8), which is tebufenpyrad:



Group IX, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-9), which is fenpyroximate:

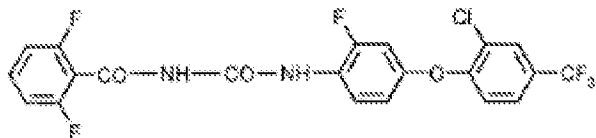


Group X, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-10), which is pyridaben:

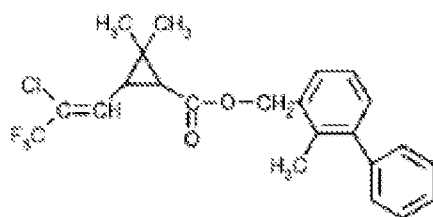


Art Unit: 1616

Group XI, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-11), which is flufenoxuron:



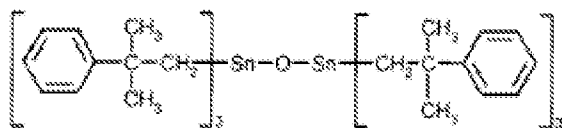
Group XII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-12), which is bifenthrin:



Group XIII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-13), which is clofentezine:



Group XIV, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-14), which is fenbutatin oxide:

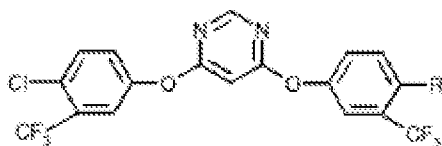


Group XV, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-15), which is tolylfluanid:



Art Unit: 1616

Group XVI, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-16), which is pyrimidyl phenol ethers of the formula:



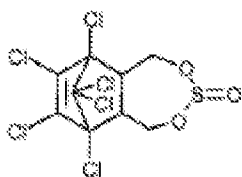
in which

- R represents fluorine (2-16-a = 4-[(4-chloro- $\alpha,\alpha,\alpha$ -trifluoro-3-tolyl)oxy]-6-[( $\alpha,\alpha,\alpha$ -4-tetrafluoro-3-tolyl)oxy]pyrimidine)
- R represents nitro (2-16-b = 4-[(4-chloro- $\alpha,\alpha,\alpha$ -trifluoro-3-tolyl)oxy]-6-[( $\alpha,\alpha,\alpha$ -trifluoro-4-nitro-3-tolyl)oxy]pyrimidine)
- R represents bromine (2-16-c = 4-[(4-chloro- $\alpha,\alpha,\alpha$ -trifluoro-3-tolyl)oxy]-6-[( $\alpha,\alpha,\alpha$ -trifluoro-4-bromo-3-tolyl)oxy]pyrimidine)

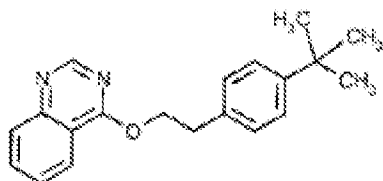
Group XVII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-17), which is a macrolide comprising mixtures of spinosyn A and spinosyn B.

Group XVIII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-18 and 2-19), which is ivermectin or milbemectin.

Group XIX, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-20), which is endosulfan:

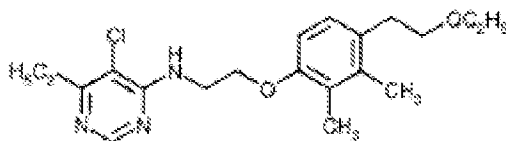


Group XX, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-21), which is fenazaquin:

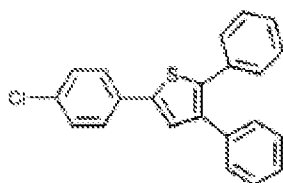


Art Unit: 1616

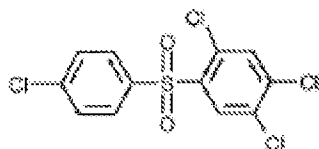
Group XXI, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-22), which is pyrimidifen:



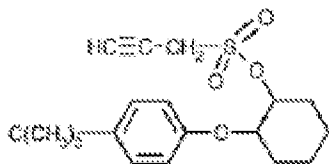
Group XXII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-23), which is triarathen:



Group XXIII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-24), which is tetradifon:



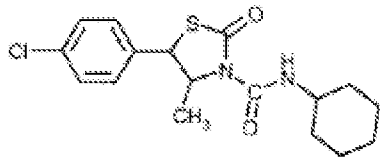
Group XXIV, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-25), which is propargite:



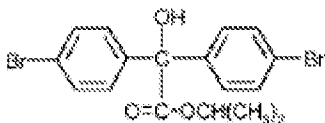


Art Unit: 1616

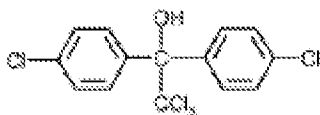
Group XXV, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-26), which is hexythiazox:



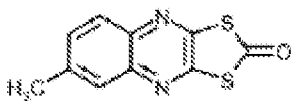
Group XXVI, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-27), which is bromopropylate:



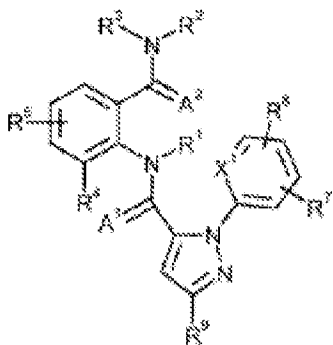
Group XXVII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-28), which is dicofol:



Group XXVIII, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide (2-29), which is chinomethionat:



Group XXIX, claims 1-5, 7-10, drawn to pesticidal composition and method comprising a compound of formula I and acaricide of formula II:



The inventions listed as Groups I to XXIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons.

Under lack of unity rules, unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. The "contribution over the prior art" is considered with respect to novelty and inventive step. Further, under Markush practice, all alternatives must have a common property AND (i) common structure must be present in all alternatives or (ii) all alternatives must belong to a recognized class of chemical compounds. See PCT Rule 13.1 and 13.2; see also MPEP 1850.

In this application, the ingredient common to all the inventions is the compound of formula I. However, compounds of formula I are known in the prior art for their pesticidal properties. See e.g. U.S. Patent 5,262,383. Consequently, the same or

Art Unit: 1616

corresponding technical feature in all of the inventions does not define a contribution which each of the inventions makes over the prior art.

Regarding the various second active ingredients, it must be noted that there is no common structure and all alternatives do not belong to a recognized class of chemical compounds.

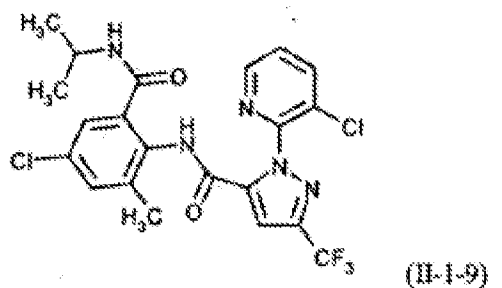
Therefore, the inventions are not so linked as to form a single general inventive concept; and the inventions lack unity of invention.

Applicant is advised that there is a further requirement to elect a single disclosed species of formula (I) compound; and in the event that invention group XXIX is elected, there is a further requirement to elect a single disclosed species of formula (II) compound. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

For inventions I to XXIX – a single disclosed species of formula I, such as for example, A<sup>3</sup> and A<sup>4</sup> together with the carbon to which they are attached form a 5-membered ring, G<sup>1</sup> is C(O)-CH<sub>2</sub>-C(CH<sub>3</sub>)<sub>3</sub>, and X, Y and Z are 2, 4, 6 methyl groups.

For invention XXIX – same as above, and additionally, a single disclosed species of formula II, such as for example:



Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

To summarize, applicant is required to elect:

- (i) one of invention from inventions groups I to XXIX,
- (ii) a single disclosed species of formula (I) compound, and
- (iii) in the event that group XXIX is elected, a single disclosed species of formula (II) compound.

Art Unit: 1616

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**.

The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/  
Primary Examiner, Art Unit 1616